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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

EFIM0233

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Application Number

10/631,115

Filed

31-Jul-2003

First Named Inventor

Paul Michel

Art Unit

2625

Examiner

HILINA S. KASSA

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 39,862  
Registration number \_\_\_\_\_

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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21-Apr-2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Paul Michel et al.  
Application No. : 10/631,115  
Filed : 31 July 2003  
For : METHODS AND APPARATUS FOR ANALYZING  
: ELECTRONIC DOCUMENTS AND DIGITAL  
: PRINTING SYSTEMS  
Group Art Unit : 2625  
Examiner : HILINA S. KASSA

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Commissioner for Patents  
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STATEMENT IN SUPPORT OF  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 10-26 and 28-33 are currently pending. All pending claims have been rejected based on Jackelen et al. U.S. Patent Publication No. 2003/0053810 (“Jackelen”). In particular, claim 10, the only independent claim, has been rejected under 35 U.S.C. § 102(e) as anticipated by Jackelen. Applicants respectfully submit that these rejections are clearly erroneous. In particular, the Examiner has failed to establish a prima facie case of anticipation of claim 10. Applicants respectfully request that this Request be granted, and that the Examiner’s rejections be withdrawn.

Independent claim 10 recites a method for analyzing a print job comprising an object having an associated print attribute, the method including determining a print attribute of interest, associating a corresponding unique marker to the determined attribute of interest, receiving PDL commands that describe the print job, interpreting the PDL commands to process the object, determining if the attribute associated with

the processed object matches the determined attribute of interest, and reporting the results of any matched object using the corresponding unique marker.

The Final Office action has rejected claim 10 as anticipated by Jackelen. However, Jackelen does not describe the claimed invention, and the Examiner has failed to proffer a prima facie case of anticipation. In particular, in the Advisory action asserts that Jared describes a print job that has a header that includes print job attributes. The Advisory action further asserts that the print job is the claimed print job “object,” and the header attributes are the claimed “print attribute associated with the object.”

A problem with this novel interpretation is that it effectively strikes the terms “object” and “associated print attributes” from the claim. Indeed, under the Examiner’s interpretation, the claimed method would reduce to a method for analyzing a print job comprising a print job having header attributes. In other words, the print job object no longer has any meaningful distinction from the print job itself. Further, “print attributes associated with the object” loses meaning when all header attributes become the print attribute associated with the object. Applicants are unaware of any principle of patentability examination that permits such rewriting of the claims.

The Advisory action further states that Jackelen describes parsing the print job header to determine the header attributes, and asserts that this parsing step constitutes the claimed “determining a print attribute of interest.” Once again, a problem with this interpretation is that it effectively eviscerates a claim term. In particular, determining an “attribute of interest” no longer has any significant meaning when all header attributes are considered an “attribute of interest.”

Moreover, the Advisory action states that Jackelen describes a pre-job “matching or association with the printer resources and capabilities,” and that “[t]he corresponding unique marker is considered as the printer resource and capabilities which determine the attribute.” First, contrary to the Examiner’s assertion, Jackelen does not describe a pre-job “matching or association with the printer resources and capabilities,” but instead describes a pre-job mismatch check to determine if there is any mismatch between any header attribute and printer resources. Second, despite repeated efforts, applicants have no idea of the Examiner’s intended meaning of “[t]he corresponding unique marker is considered as the printer resource and capabilities which determine the attribute.” Moreover, applicants cannot understand how this

statement is supposed to pertain to the claimed step of “associating a corresponding unique maker to the determined attribute.”

In addition, the Advisory action states that Jackelen describes “wherein the print job attributes get checked or determined if it is associated with the printer resource or capabilities.” Once again, applicants have difficulty comprehending the meaning of this statement, which does not seem to be a complete sentence. More importantly, applicants cannot comprehend how this statement is in any way related to the claimed step of determining if the attribute associated with the processed object matches the determined print attribute of interest.

The Advisory action additionally states that Jackelen discloses that if a “mismatchc [sic] is detected between the print job attribute and the printer resource which is considered as the unique match maker, a message is displayed on the printer user interface informing the user about the mismatch state.” Applicants respectfully submit that this sentence also makes no sense. To the extent that the sentence describes something about mismatch reporting, such a teaching seems wholly unrelated to the claimed step of reporting the results of any matched object using the corresponding unique marker.

Further, because the Examiner has interpreted the entire print job to be the object, the claim phrase “reporting the results of any matched object (i.e., print job) using the corresponding unique marker,” make no sense.

Indeed, inserting the Examiner’s definition of various claim terms into the claims illustrates how the Examiner’s interpretation effectively deletes various claim terms from the claim, and renders the claim nonsensical:

Claim 10	Version Using Examiner’s Definition
A method for analyzing a print job comprising an <u>object</u> having <u>an associated print attribute</u> , the method comprising:	A method for analyzing a print job comprising a <u>print job</u> having <u>header attributes</u> , the method comprising:
determining a <u>print attribute of interest</u> ;	determining <u>all of the header attributes</u> ;
associating a corresponding unique marker to the <u>determined attribute</u> ;	associating a <u>printer resource and capabilities</u> to the determined <u>all of the header attributes</u> ;

Claim 10	Version Using Examiner's Definition
receiving page description language ("PDL") commands that describe the print job;	receiving page description language ("PDL") commands that describe the print job;
interpreting the PDL commands to process the <u>object</u> ;	interpreting the PDL commands to process the <u>print job</u> ;
determining if the <u>attribute</u> associated with the <u>processed object</u> matches the <u>determined attribute</u> ; and	determining if the <u>header attribute</u> associated with the <u>processed print job</u> matches the <u>all of the header attributes</u> ; and
reporting the results of any matched <u>object</u> using the corresponding <u>unique marker</u> .	reporting the results of any matched <u>print job</u> using the corresponding <u>printer resource and capabilities</u> .

As previously stated, Jackelen does not describe or suggest the claimed invention. Applicants should not be required to incur the time and additional expense of preparing and filing an appeal brief, and further prosecuting an appeal of the clearly erroneous rejections in this case. Accordingly, applicants respectfully request that this Request be granted, and that the Examiner's rejections be withdrawn.

Respectfully submitted,

/James Trosino, Reg. # 39,862/  
James Trosino  
Attorney for Applicants